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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,746	06/21/2001	Takashi Kunii	393032026400	7489
25224 7590 07/18/2007 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/887,746	Applicant(s) KUNII, TAKASHI	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,41-46,50-55 and 59-70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18,41-46,50-55 and 59-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the paper(s) filed 4/9/07.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5, 10-14, 59, 60, 62, 63, 65, 66, 68, 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1-5, 10-14, 59, 60, 62, 63, 65, 66, 68, 69 provide apparatus/system claims which should set forth programmed capabilities rather than apparent method steps. Applicant should specify elements programmed to (or configured to) accomplish a function, rather than claim performance of such functions.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-18, 41-46, 50-55 and 59-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blass et al (US6296489).**

Regarding claim 1, the claims are directed to a server which selects targeted ads for music training users according to musical information received. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that demographically targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference received client information including the type of musical instrument being used by a client, this client information is not functionally related to the rest of the claim, as there is no client which positively collects and reports the needed information upon which targeting is made. Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The targeting steps (match the advertisement to some received client-criteria to select an appropriately targeted ad) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have relied upon any client information for targeting. Such client information does not

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functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 4, the claims are directed to a client which reports client information indicative of the type of musical instrument being used and which renders ads received from a server. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that user demographics are provided to the server so that targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference client information including the type of musical instrument being used by a client, this client information is not functionally related to the rest of the claim, as there is no server which receives the user information and makes an advertising selection based upon the information.

Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The transmitting steps (send client-criteria to a server as a basis for targeting) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir.

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1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have sent any client information to the server for targeting. Such client information does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention. The broad tone generation claimed can be met by the multimedia capabilities of the client system. Even the sounds typically associated with a user interface (error beep, click sounds, confirmation tones, etc.) provide tone generation "related to musical training" when the user is interfacing with the client for any purposes having to do with musical training (booting up, logging in to the training website, selecting training material, etc.). Further, the system is capable of outputting musical passages via the playback function [7:17] which is used during training. Further still, Blass et al teaches the coupling of musical instruments to the inputs on the sound board in order to capture the student's musical works [7:67+] . In this manner, the student's musical instrument forms part of the client apparatus/system and also meets the tone generation claimed.

Regarding claim 6, the claims are directed to a server which selects targeted ads for music training users as well as a client which receives and renders the ads. Blass et al teaches the concept of musical training over the Internet by way of students downloading teacher's training content and the student uploading his musical creations for review and analysis [4:3-15, 7:1-20, 8:14-19, 11:30-54]. Blass et al teaches that demographically targeted ads may be selected (based upon certain client information) and sent to the music training students [4:47-55]. While these claims reference client information including the type of musical instrument being used by a client, the client

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does not collect and report the needed information and therefore such information is not functionally related to the rest of the claim. Regarding the specific data content present referred to in the claims of "the type of performance equipment being used in a particular client apparatus", it could be argued that Blass et al does not teach such data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The reporting and targeting steps (report client information by a client, match by a server the advertisement to some client-criteria to select an appropriately targeted ad) would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have relied upon any client information for targeting. Such client information does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention. The broad tone generation claimed can be met by the multimedia capabilities of the client system. Even the sounds typically associated with a user interface (error beep, click sounds, confirmation tones, etc.) provide tone generation "related to musical training" when the user is interfacing with the client for any purposes having to do with musical training (booting up, logging in to the training website, selecting training material, etc.). Further, the system is capable of outputting musical passages via the playback function [7:17] which is used during training. Further

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still, Blass et al teaches the coupling of musical instruments to the inputs on the sound board in order to capture the student's musical works [7:67+] . In this manner, the student's musical instrument forms part of the client apparatus/system and also meets the tone generation claimed.

Independent claims 10, 13, 15 are treated similarly. Even though they specify music content information rather than musical instrument information, they still provide non-functional descriptive material which cannot form the basis for patentability.

Regarding claims 2, 3, 5, 7-9, 11, 12, 14, 16-18, 59-64, Blass et al teaches a pay-per-view model for each music lesson [6:54-56]. It would have been obvious to one of ordinary skill at the time of the invention to have used the student information such as user's type of instrument or type of music content (classical piano, jazz guitar, etc) as a basis (in addition to or instead of demographics) for advertising other similar training modules (more advanced piano modules, more advanced classical modules, more advanced jazz modules, more advanced guitar modules available from the system or pianos, guitars, classical CDs, jazz CDs, etc available from other sources) so as to encourage the student to continue development with an instrument or to encourage the student to try additional instruments and/or lessons related to additional instruments. Further regarding the selection, delivery and receipt of advertising as well as information for musical performance training, any differences between the delivered ads/information are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material

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(information for musical performance training) will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have selected/sent/received any type of data content to the user as advertisement. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claims 41-46, 50-55, the computer-based methods and systems of Blass et al are taken to also read on these methods and computer-instruction-based claims with similar analysis as above

Regarding claims 65-70 and the choices for training at the server and the client's selection of such as well as the associated billing, Blass et al teaches that instructors/publishers can upload lessons (i.e. make selections available) to the server [4:10-13]. Blass et al also teaches that fees may be charged according to each training lesson selected for download by the client [6:50-65].

Response To Arguments

Applicant notes that the examiner stated that certain claims failed to positively claim either the client or the server. Applicant attempted to amend the claims to positively require them. In the case of claim 1, there still is no client positively set forth. The claim is directed to a server which cannot set forth structure/features of the client.

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While the client is mentioned, there is no musical performance being practiced by the client, nor any collection of the musical information by the client, nor delivery capabilities of the client. Applicant merely claims receipt of information and targeting accordingly. Further however, the examiner presented numerous arguments why the advertising targeted to the user's musical instrument/performance would be obvious. These arguments are repeated again herein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc